

### **REMARKS**

This is in response to the Office Action dated December 1, 2009, in which the Examiner has required restriction between Group I (namely, Claims 1–7, 10–13, and 21–26) and Group II (namely, Claims 14–20). Applicant respectfully disagrees with the requirement for restriction for the reasons provided below and requests that the restriction requirement be withdrawn. In the alternative, Applicant hereby elects with traverse to prosecute the claims of Group I (namely, Claims 1–7, 10–13, and 21–26).

As a preliminary matter, Applicant has amended Claims 1, 2, 10, 21, and 23 to clarify the claimed invention. In particular, the phrase “capable of” has been removed and the claim language modified accordingly. For example, in Claim 1, element (c) has been amended to read “imposing on the filament a change of cross section so as to partially reorient the molecular chains in a transverse direction.” In view of this amendment, the note on Page 2 of the Office Action that “‘capable of’ in your claims in the US does not constitute a limitation, only the ability to so perform” is moot. Thus, the common features between the two groups include element (c), i.e., the fact that the change of cross-section causes a partial reorientation of the molecular chains in a transverse direction.

Furthermore, Applicant respectfully submits that the Examiner has not provided an adequate basis for requiring restriction between Groups I and II, and thus the requirement for restriction is improper. Two requirements exist for supporting a proper restriction requirement. First, 37 CFR § 1.142 requires that restricted inventions be “independent and distinct.” According to MPEP § 802.01, “independent” requires that there is not a disclosed relationship between the two or more subjects disclosed. Inventions are “distinct” if the inventions as claimed are not related in at least one of design, operation, or effect. Second, there must be “a serious burden on the Examiner if restriction is not required” in order for restriction to be proper. See MPEP § 803 (stating that “[i]f the search and examination of all the claims in an application

can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to patentably distinct inventions”).

Independent Claims 1 and 21 recite, *inter alia*, a method of producing a cutting filament, the filament being made of a synthetic material having elongated molecular chains, by bringing the filament to a state of controlled viscosity, drawing the filament lengthwise to produce a first longitudinal molecular orientation, and imposing on the filament a change of cross section so as to partially reorient the molecular chains in a transverse direction. Claim 14 recites a cutting filament, the filament being made of a synthetic material with elongated molecular chains, wherein, in at least one zone of the cross section of the filament, the orientation of the molecular chains diverges from a longitudinal orientation. Independent Claims 1, 14, and 21 are thus related in terms of at least their subject, configuration, and effect. Accordingly, Applicant respectfully submits that the first criterion for restriction under 37 CFR § 1.142 is not met.

Furthermore, the Office Action does not provide any indication that examination of all of the pending claims would result in an undue examination and search burden, and Applicant submits that no such burden would be imposed. MPEP § 803 states that “[e]xaminers must provide reasons and/or examples to support conclusions” and that “a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02.” MPEP § 803, Guidelines (emphasis added). The Office Action does not provide any reasons or examples to indicate that an undue burden exists. More particularly, the Office Action does not provide specific evidence of: (a) different classifications among each of the alleged inventions; (b) acquisition of separate status in the art due to recognized divergent subject matter among each of the alleged inventions; (c) different fields of searches among each of the alleged inventions; (d) prior art that might be applicable to one alleged invention but not applicable to each of the other alleged inventions; (e) likely non-prior art issues that might be raised by examination of one alleged invention but not each of the other alleged inventions. Accordingly, the Office Action does not fulfill the second requirement for restriction under 37

CFR § 1.142, *i.e.*, the burden of providing a *prima facie* showing of reasons for insisting on restriction by appropriate explanation and evidence. *See* MPEP § 808.02. *See also* MPEP § 803, Guidelines.

Instead, the Office Action cites the search report for PCT/FR04/00105 as showing element (b) of Claim 1 in EP 0867108 and states that “there can be no Unity of Invention when the STF is shown in the prior art.” Office Action dated December 1, 2009, page 2. The Office Action’s reliance on the referenced search report as a rationale for requiring restriction is erroneous for several reasons.

First, the search report for PCT/FR04/00105 did not find a lack of Unity in the claims and, to the contrary, examined all of the pending PCT claims. Thus, the Examiner’s holding that there is lack of unity under PCT rule 13 and 37 CFR 1.475 is not in accordance with the actual results of examination by the PCT Examiner in the search report for PCT/FR04/00105.

Second, the search report for PCT/FR04/00105 makes no mention of EP 0867108, as asserted in the Office Action, let alone providing that the alleged STF is shown in EP 0867108. Applicant is unable to determine the Examiner’s basis for making this statement. With reference to the English equivalent of EP 0867108, U.S. Pat. No. 6,630,226 (“the ‘226 patent”), the ‘226 patent is directed to a cutting line that consists of a core of the monofilament type, which is coated with a granular coating, especially in the form of inorganic particles, to provide for a lower operating noise, a better cutting effect, and reduced sticking and breaking at the eyelet in the rotary head. The ‘226 patent does not teach or suggest drawing a filament lengthwise to produce a first longitudinal molecular orientation and/or imposing on the filament a change of cross section so as to partially reorient the molecular chains in a transverse direction, for example, as recited in Claim 1. Thus, EP 0867108 does not show the special technical features of Group I (or Group II).

In view of the amended claims and the fact that the Examiner has not provided an adequate basis for requiring restriction between Groups I and II and that no lack of unity was found in the corresponding PCT search report, Applicant respectfully submits that the restriction

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requirement is improper and requests that the requirement be withdrawn. In the alternative, Applicant elects with traverse to prosecute the claims of Group I (namely, Claims 1-7, 10-13, and 21-26).

Furthermore, Applicant submits that the pending claims of the present application are in condition for allowance. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Michele M. Glessner  
Registration No. 58,713

**Customer No. 00826**  
**ALSTON & BIRD LLP**  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Charlotte Office (704) 444-1000  
Fax Charlotte Office (704) 444-1111

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